

### REMARKS

This is a full and timely response to the non-final Office Action mailed August 2, 2004 (Paper No. 23). The present amendment amends claims 1, 5, 7, 10, 15, 19, 20, 22 and 24 in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claims. Claims 6 and 16 have been cancelled. Support for these amendments can be found variously throughout the specification, including, for example, page 14, line 14 to page 15, line 22. No new matter has been added. Reexamination and reconsideration in light of the present amendment and the following remarks are respectfully requested.

#### Examiner's Interview

The Applicant thanks the examiner for the courtesies extended during the telephonic interview held on Friday, October 29, 2004. The present Amendment incorporates the various amendments and arguments proposed by the Applicant during this interview with the examiner.

#### Claim Rejections- 35 U.S.C. § 103

In the Action, claims 1, 2, 5-7, 10, 13-17, 19-22, 24, 25 and 27-30 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,214,792 to Alwadish ("Alwadish") in view of U.S. Patent No. 6,516,466 to Jackson ("Jackson"). This rejection is respectfully traversed in light of the present amendment.

Independent claim 1 of the present invention recites a method of providing listeners with information about audio programming being digitally broadcast comprising, *inter alia*, transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming that is ***indicated by contextual information being displayed substantially contemporaneously with the broadcast audio programming on a display device.***

The present invention allows for the broadcast and reception of an audio signal and the simultaneous display of its related contextual information such that the audio signal may be transduced into audible sound at the same time the contextual information is displayed on a display device. See page 10, line 13 to page 11, line 21. In addition, users may input a request

to purchase the audio programming being broadcast, indicated by the contextual information being displayed substantially contemporaneously with the broadcast audio programming on the display device, such that a purchase signal may be transmitted to a service provider indicating an order to purchase a recording of the audio programming being broadcast. *See* page 14, line 14 to page 15, line 22.

In contrast, Alwadish and Jackson, either alone or in combination, fail to disclose, teach or suggest at least the step of transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming that is indicated by contextual information being displayed substantially contemporaneously with the broadcast audio programming on a display device.

Alwadish arguably teaches of receiving and displaying information pertaining to broadcast program material, such as a song title or artist name. *See* Abstract. However, as conceded on page 3 of the outstanding Action, Alwadish fails to disclose, teach or suggest *at least* the step of transmitting a purchase signal to a service provider indicating an order to purchase a recording of a broadcast audio programming that is indicated by contextual information being displayed substantially contemporaneously with the broadcast audio programming on a display device, as is recited in claim 1 of the present invention.

Jackson arguably teaches of a method and apparatus for transmitting a signal to a microwave cellular tower 12 indicating a song desired to be purchased by a user. *See* col. 3, lines 54-67. However, Jackson clearly fails to disclose, teach or suggest *at least* the step of transmitting a purchase signal to a service provider indicating an order to purchase a recording of a broadcast audio programming that is *indicated by contextual information being displayed substantially contemporaneously with the broadcast audio programming on a display device*, as is recited in claim 1 of the present invention.

Not only does Jackson fail to disclose, teach or suggest broadcasting audio programming to a user, Jackson additionally fails to disclose, teach or suggest transmitting a purchase signal indicating an order to purchase a recording of this broadcast audio programming indicated by contextual information displayed substantially contemporaneously with the broadcast audio programming. In other words, Jackson merely arguably discloses transmitting a signal to a microwave cellular tower 12 indicating a song desired to be purchased indicated by a static list of potential musical selections displayed on the LCD window 46. *See* col. 3, lines 54-67.

Most importantly, the examiner has failed to point to or provide any reason why one of ordinary skill in the art would have been led to modify the Alwadish and/or Jackson references in the manner suggested, as has been required by the Federal Circuit and the Board of Patent Appeals and Interferences. *See Ex Parte Clapp*, 227 USPQ 972, 973 (Bd.Pat.App. & Interf. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, and not from the Applicant's disclosure. *See In re Rouffet*, 149 F.3d 1350, 1354 (Fed. Cir. 1998). With regards to the present rejection, no such findings have been made.

Thus, for at least the foregoing reasons, Alwadish and Jackson, either alone or in combination, fail to disclose, teach or suggest at least the step of transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming that is indicated by contextual information being displayed substantially contemporaneously with the broadcast audio programming on a display device, as is recited in claim 1 of the present invention. Accordingly, since the applied art fails to teach each and every limitation recited in claim 1, and further since the requisite motivation to modify or combine the prior art references has not been demonstrated, a prima facie rejection of the claims has not been established. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"); *Accord.* MPEP § 2143.03. Withdrawal of this rejection is therefore respectfully requested.

Independent claim 5 recites, *inter alia*, a user input device for controlling transmission of contextual information over a connection to a service provider and for generating requests to be transmitted to the service provider to purchase a recording of a particular audio programming indicated by contextual information being displayed substantially contemporaneously with a broadcast signal on a display device.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Alwadish and Jackson, either alone or in combination, fail to disclose, teach or suggest *at least* a user input device for generating requests to be transmitted to the service provider to purchase a recording of a particular audio programming indicated by contextual information being displayed substantially contemporaneously with a broadcast signal on a display device, as

is recited in claim 5 of the present invention. Arguments in support of the allowability of claim 5 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Independent claim 15 recites, *inter alia*, transmitting a purchase signal to a service provider indicating an order to purchase a recording of an audio programming that is indicated by contextual information being displayed substantially contemporaneously with a broadcast signal on a display device.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Alwadish and Jackson, either alone or in combination, fail to disclose, teach or suggest *at least* transmitting a purchase signal to a service provider indicating an order to purchase a recording of an audio programming that is indicated by contextual information being displayed substantially contemporaneously with a broadcast signal on a display device, as is recited in claim 15 of the present invention. Arguments in support of the allowability of claim 15 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Independent claim 22 recites, *inter alia*, means for transmitting at least a portion of contextual information to a service provider to purchase a recording of an audio programming indicated by the contextual information being displayed substantially contemporaneously with a broadcast signal.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Alwadish and Jackson, either alone or in combination, fail to disclose, teach or suggest *at least* means for transmitting at least a portion of contextual information to a service provider to purchase a recording of an audio programming indicated by the contextual information being displayed substantially contemporaneously with a broadcast signal, as is recited in claim 22 of the present invention. Arguments in support of the allowability of claim 22 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Moreover, aside from the novel limitations recited therein, claims 2, 7, 10, 13, 14, 17, 19-21, 24, 25 and 27-30, being dependent either directly or indirectly upon allowable base claims 1, 5, 15 or 22, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 31-34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Alwadish in view of Jackson and further in view of U.S. Patent No. 5,918,213 to Bernard ("Bernard"). This rejection is respectfully traversed. Aside from the novel limitations recited

therein, claims 31-34, being directly dependent upon allowable base claims 1, 5, 15 and 22, respectively, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore respectfully requested.

Conclusion:

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SOA-246, from which the undersigned is authorized to draw.

Dated: November 2, 2004

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant